

10-23-06



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FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10

EV304413558US
Express Mail Label Number

October 20, 2006
Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

ROBERT J. PEACH ET AL.

PATENT NO: 7,094,874

ISSUED: AUGUST 22, 2006

FOR: SOLUBLE CTLA4 MUTANT MOLECULES AND USES THEREOF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

FEE LETTER FOR APPLICATION TO CORRECT PATENT TERM ADJUSTMENT
PERIOD IN GRANTED PATENT UNDER 37 C.F.R. §§ 1.181 & 1.705

Sir:

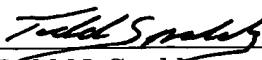
Please charge Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company in the amount of \$200 for payment of the fee pursuant to 37 C.F.R. § 1.18(e) for filing an application for patent term adjustment under §1.705.

An additional copy of this paper is here enclosed. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000

Date: October 20, 2006


Todd N. Spalding
Attorney for Applicants
Reg. No. 55,638
Phone No. (609) 252-3034

FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10EV304413558US
Express Mail Label NumberOctober 20, 2006
Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

ROBERT J. PEACH ET AL.

PATENT NO: 7,094,874

ISSUED: AUGUST 22, 2006

FOR: SOLUBLE CTLA4 MUTANT MOLECULES AND USES THEREOF

Mail Stop: PETITIONS
Director, U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION TO CORRECT PATENT TERM ADJUSTMENT PERIOD
IN GRANTED PATENT UNDER 37 C.F.R. §§ 1.181 & 1.705

Sir:

This is a request for reconsideration of the revised patent term adjustment for the captioned patent. The patent erroneously lists the patent term adjustment period as 253 days. In fact, the patent term adjustment period should be 365 days, as explained below.

The USPTO ("the Office") made three errors in calculating the patent term adjustment for events that occurred after it mailed the Notice of Allowance. First, the Office improperly charged Applicants with 8 days of delay for filing a supplemental Application Data Sheet (ADS) that the Office itself requested. Second, the Office erroneously charged Applicants with 29 days of delay for filing a first corrected drawing, when Applicants had no warning before the Notice of Allowance that

corrected drawings would be necessary. Third, the Office incorrectly charged Applicants with 75 days of delay for filing a second set of corrected drawings, again when Applicants had no warning before the Notice of Allowance that corrected drawings would be necessary.

Applicants Should Not Be Charged with Delay for Filing the Supplemental ADS

The Office charged Applicants with 8 days of delay for filing a supplemental ADS on April 20, 2006 (copy attached as Appendix A), but should not have charged Applicants with any delay.

Applicants filed the supplemental ADS only at the examiner's express request and to assist the Office in its duties. On April 19, 2006, the examiner contacted Applicants and requested the supplemental ADS having updated priority claim information (see the Examiner-Initiated Interview Summary attached as Appendix B). Significantly, the ADS *did not amend* Applicants' priority claim. The priority claim had been updated with a newly available application number more than *three years earlier* by Preliminary Amendment (copy attached as Appendix C). The Office acknowledged that update in an Office Action dated October 1, 2003 (copy attached as Appendix D). The supplemental ADS, therefore, merely updated information on the original ADS.

Applicants filed the supplemental ADS to help the Office perform its duties, and not for their own benefit. Applicants did not have to do so, despite the examiner's request. Indeed, 37 C.F.R. § 1.76(a) explicitly states that an ADS is "voluntarily submitted."

It is manifestly unfair for the Office to penalize Applicants 8 days of patent term adjustment for voluntarily complying with an express request from the examiner. Moreover, the law prohibits the Office from doing so. According to 37 C.F.R. § 1.704(c)(8), Applicants will only be charged with delay for supplemental filings "other than a supplemental reply or other paper expressly requested by the examiner."

For at least these reasons, the Office should add 8 more days to the patent term adjustment.

*Applicants Should Not Be Charged with Delay for Filing
the First Corrected Drawing*

The Office charged Applicants with 29 days of delay for filing a corrected drawing on May 11, 2006 (copy of the filing attached as Appendix E), but should not have charged Applicants with any delay.

Applicants filed original drawings with the application on May 23, 2001 (see the Utility Patent Application Transmittal attached as Appendix F), but received no notice of a problem with those drawings until April 27, 2006 – nearly *five years* after filing the drawings and after receiving the Notice of Allowance – when the Office mailed a Notice of Drawing Inconsistency with Specification (copy attached as Appendix G). The Office should have provided Applicants with earlier notice, as it reviews drawings much earlier in the application process. First, an initial review of the drawings should have occurred in the Office of Initial Patent Examination (OIPE). MPEP § 507. OIPE should have “inspect[ed] the drawings to see if they can be effectively scanned and adequately reproduced,” and if it identified a problem should have sent Applicants a notice requiring corrected drawings. MPEP § 507. Once the examiner received the application, he should have “review[ed] the drawings for disclosure of the claimed invention and for proper use of reference numerals.” MPEP § 608.02(b). He also should have “see[n] to it that the figures are correctly described in the brief description . . . of the drawing section of the specification, that the reference characters are properly applied, that no single reference character is used for two different parts or for a given part and a modification of such part, and that there are no superfluous illustrations.” MPEP § 608.02(e). If any problems were found, the examiner should have notified Applicants. MPEP §§ 608.02(b) & 608.02(e). Neither OIPE nor the examiner sent any notice to Applicants after such initial reviews.

In the absence of any notice that the drawings were flawed, Applicants rightfully assumed that they were acceptable and proceeded with other aspects of prosecuting the patent application. In that regard, 37 C.F.R. § 1.85(a) states that an “application will not be placed in the files for examination until objections to the drawings have been corrected.” Accordingly, once examination began and Applicants received no notice to the contrary, Applicants had every reason to believe that they had fulfilled their obligation to provide acceptable drawings and an acceptable brief description of those drawings to the Office.

It is improper for the Office to penalize Applicants for its own oversight. Applicants are entitled to rely on the Office to perform its duties, and should not bear the burden of its failure to do so. For at least these reasons, the Office should add 29 more days to the patent term adjustment.

If the Office disagrees with Applicants’ position concerning the 29-day adjustment, it should nevertheless add 7 more days to the patent term adjustment because the 29-day calculation is incorrect. The Office received Applicant’s corrected drawing on May 11, 2006 and acted on that drawing June 1, 2006, when it mailed a Notice Regarding Drawings (copy attached as Appendix H). Only 22 days, not 29 days elapsed between those two dates. The difference of 7 days, at a minimum, should be additional patent term adjustment.

*Applicants Should Not Be Charged with Delay for Filing
the Second Corrected Drawings*

The Office charged Applicants with 75 days of delay for filing a second set of corrected drawings on June 9, 2006 (copy of the filing attached as Appendix I), but should not have charged Applicants with any delay.

The Notice Regarding Drawings mailed June 1, 2006 complained of “poor line quality” in Figures 11 and 12 and required Applicants to submit a second set of corrected drawings. However, that notice should have been sent five years earlier,

with the initial OIPE review of the drawings. Again, OIPE should have “inspect[ed] the drawings to see if they can be effectively scanned and adequately reproduced,” including determining whether the drawings “have a line quality that is too light to be reproduced.” MPEP § 507. If it identified a problem, OIPE should have sent Applicants a notice requiring corrected drawings. MPEP § 507. Once substantive examination began, Applicants could only believe that its drawings were in order, as 37 C.F.R. § 1.85(a) states that an “application will not be placed in the files for examination until objections to the drawings have been corrected.” This was especially true after the Office published the application (U.S. Pub. No. 2002/0182211, copy of front page attached as Appendix J) on December 5, 2002, giving Applicants still more reason to believe that its drawings were acceptable.

The Office should not place the burden of its own delay on Applicants, who received no warning of “poor line quality” in Figures 11 and 12 until after receiving a Notice of Allowance. Moreover, Applicants responded to the Office’s late notice within a mere 8 days, yet were charged with 75 days of delay. For at least these reasons, the Office should grant back to Applicants the 75 days of patent term adjustment.

Should the Office disagree with Applicants’ position concerning the 75-day adjustment, it should nevertheless add 20 more days to the patent term adjustment because the 75-day calculation is incorrect. The Office received Applicant’s second set of corrected drawings on June 9, 2006 and acted on them by August 2, 2006, when it mailed an Issue Notification containing a modified determination of patent term adjustment (copy attached as Appendix K). Only 55 days, not 75 days elapsed between those two dates. The difference of 20 days, at a minimum, should be additional patent term adjustment.

No Actual Delay Occurred

An additional consideration in this case is that none of Applicants' actions *actually* delayed issuance of the patent. The Notice of Allowance projected that the patent would issue on August 22, 2006, and the patent did issue on August 22, 2006. Charging Applicants with delays that never actually occurred not only is unfair, but is illogical and contrary to the purposes of the controlling statutes and regulations.

Calculation of Patent Term

The patent term adjustment history from PAIR shows a USPTO Delay of 543 days and Applicants' Delay of 290 days, calculated as follows:

USPTO Delay:

08-02-06	PTA 36 Months	84 days
08-22-06	Patent Issue Date Used in PTA Calculation	24 days
10-01-2003	Mail Restriction Requirement	<u>435 days</u>
		543 days

Applicants' Delay:

06-09-06	Workflow – Drawings Finished	75 days
05-11-06	Workflow – Drawings Finished	29 days
04-20-06	Miscellaneous Incoming Letter	8 days
01-23-06	Information Disclosure Statement Filed	10 days
10-24-05	Notice of Appeal Filed	87 days
07-19-04	Response after Non-Final Action	42 days
06-07-04	Response after Non-Final Action	<u>39 days</u>
		290 days

As explained above, the delays of 8 days for filing a supplemental ADS (Miscellaneous Letter) on April 20, 2006, 29 days for filing corrected drawings on May 11, 2006, and 75 days for filing corrected drawings on June 9, 2006 were erroneously

charged to Applicants. Accordingly, Applicants' period of delay should be recalculated to 178 days:

Applicants' Delay (Corrected):

06-09-06	Workflow – Drawings Finished	0 days
05-11-06	Workflow – Drawings Finished	0 days
04-20-06	Miscellaneous Incoming Letter	0 days
01-23-06	Information Disclosure Statement Filed	10 days
10-24-05	Notice of Appeal Filed	87 days
07-19-04	Response after Non-Final Action	42 days
06-07-04	Response after Non-Final Action	<u>39 days</u>
		178 days

Using the corrected period of Applicants' delay, the patent term adjustment should be 365 days: 543 days USPTO delay – 178 days Applicant delay = 365 days patent term adjustment.

As Applicants believe the errors are ascribable to the Office, Applicants request correction of the patent term adjustment to 365 days. The patent is not subject to any terminal disclaimer that would impact such a correction.

Timeliness of this Application

As this application is being filed within two months of the patent's issue date, it is timely under 37 C.F.R. § 1.705(d).


Application Fees

Please charge the fee prescribed in 37 C.F.R. § 1.18(e) to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company. If any additional fees are required for consideration of this application, please charge them to the same account.

Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000

Date: October 20, 2006



Todd N. Spalding
Attorney for Applicants
Reg. No. 55,638
Phone No. (609) 252-3034

Appendix A – Supplemental Application Data Sheet

APR. 20. 2006 1:33PM

BMS PATENT DEPT

NO. 1564 P. 2

RECEIVED
CENTRAL FAX CENTER

D0028 NP

APR 20 2006

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being facsimile transmitted to 571-273-8300, the United States Patent and Trademark Office, on the date shown below.

Briana C. Bergen
Type or print name


Signature

April 20, 2006
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF
ROBERT PEACH, ET AL
APPLICATION NO: 09/885321
FILED: 05/23/2001

ART UNIT: 1644
EXAMINER: OUSPENSKI, ILIA

FOR: SOLUBLE CTLA4 MUTANT MOLECULES

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

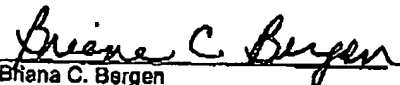
COMMUNICATION

Sir:

In accordance with Examiner Ilia Ouspenski's request, submitted herewith is a Supplemental Application Data Sheet.

Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000


Briana C. Bergen
Attorney for Applicant
Reg. No. 39,123
Phone: 800-252-4318
Date: April 20, 2006

SUPPLEMENTAL APPLICATION DATA SHEET

Attorney Docket Number: D0028 NP

RECEIVED
CENTRAL FAX CENTER**APR 20 2006**

Publication Filing Type: New utility
Application No.: 09/865,321
Application Type: Utility
Title of Invention: SOLUBLE CTLA4 MUTANT MOLECULES
Attorney Docket Number: D0028 NP

Legal Representative:

Attorney or Agent: Audrey F. Sher
Registration Number: 39,024

Customer Number Correspondence Address: 23914
23914

Continuity Data:

This application claims the priority of U.S. Serial No. 60/287,576, filed May 26, 2000, (formerly U.S. Serial No. 09/579,927) and U.S. Serial No. 60/214,065, filed June 26, 2000.

INVENTOR(s):

Inventor One

Given Name: Robert
Middle Name: J.
Family Name: Peach
Residence City: San Diego
Residence State: CA
Residence Country: US
Address: 12848 Via Caballo Rojo
San Diego CA, 92129
Primary Citizenship: New Zealand

Inventor Two

Given Name: Joseph
Middle Name: Roy
Family Name: Naemura
Residence City: Bellevue
Residence State: WA
Residence Country: US
Address: 2627 127th Avenue NE
Bellevue, WA 98005
Primary Citizenship: USA

Inventor Three

Given Name: Peter
Middle Name: S.
Family Name: Linsley
Residence City: Seattle
Residence State: WA
Residence Country: US
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Primary Citizenship: USA

Inventor Four

Given Name: Jurgon
Family Name: Bajorath
Residence City: Lynwood
Residence State: WA
Residence Country: US
Address: 17406 37th Avenue
Lynwood, WA 98037
Primary Citizenship: Germany

Appendix B – Examiner-Initiated Interview Summary



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,321	05/23/2001	Robert J. Peach	D0028PNP;30436.57USU1	2959

23914 7590 04/27/2006
LOUIS J. WILLE
BRISTOL-MYERS SQUIBB COMPANY
PATENT DEPARTMENT
P O BOX 4000
PRINCETON, NJ 08543-4000

EXAMINER

OUSPENSKI, ILIA I

ART UNIT PAPER NUMBER

1644

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Examiner-Initiated Interview Summary	Application No.	Applicant(s)	
	09/865,321	PEACH ET AL.	
	Examiner	Art Unit	
	ILIA OUSPENSKI	1644	

All Participants:

Status of Application: allowed.

(1) ILIA OUSPENSKI.

(3) _____.

(2) Michelle King, on behalf of Audrey Sher.

(4) _____.

Date of Interview: 19 April 2006

Time: _____

Type of Interview:

- ☒ Telephonic
☐ Video Conference
☐ Personal (Copy given to: ☐ Applicant ☐ Applicant's representative)

Exhibit Shown or Demonstrated: ☐ Yes ☐ No

If Yes, provide a brief description:

Part I.

Rejection(s) discussed:

Claims discussed:

Prior art documents discussed:

Part II.

SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:

See Continuation Sheet

Part III.

- ☐ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability.
☒ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.


 (Examiner/SPE Signature) _____ (Applicant/Applicant's Representative Signature – if appropriate)

Continuation of Substance of Interview including description of the general nature of what was discussed: Applicant was advised that an amendment to correct the first line of specification, and a supplemental ADS are required to correct the priority claim. Currently the ADS and specification refer to 09/579,927; however, they need to refer to 60/287,576, to which 09/579,927 has been converted.

Appendix C – Preliminary Amendment of February 24, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert J. Peach et al.
Serial No.: 09/865,321
Filed: May 23, 2001
Docket: D0028PNP;30436.57USU1
Title: SOLUBLE CTLA4 MUTANT MOLECULES AND USES THEREOF

CERTIFICATE UNDER 37 CFR 1.8

I hereby certify that this paper or fee is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on February 24, 2003.

By: 
Name: Tracy Truick

55 South Lake Avenue, Suite 710
Pasadena, California 91101
February 24, 2003

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

We are transmitting herewith the attached:

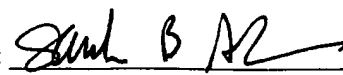
- ☒ Transmittal sheet, in duplicate, containing Certificate under 37 CFR 1.8.
- ☒ Preliminary Amendment (4 pages)
- ☒ Exhibit A- A photocopy of page 1 from the originally filed application. (1 page)
- ☒ Exhibit B- A photocopy of the Petition dated March 12, 2001. (5 pages)
- ☒ Exhibit C- Decision of Petition dated May 31, 2001. (1 page)
- ☐ No Additional fee is required
- ☒ The fee has been calculated as shown below in the "Claims as Amended" table

CLAIMS AS AMENDED

Claims Remaining After Amendment		Highest Number Previously Paid For		Present Extra		Rate		Fee
Total Claims								
71	-	71	=	0	x	0.00	=	\$0.00
Independent Claims								
10	-	14	=	0	x	0.00	=	\$0.00
MULTIPLE DEPENDENT CLAIM FEE								\$0.00
TOTAL FILING FEE								\$0.00

Please charge any fees or credit overpayment to Deposit Account No. 50-0306. A duplicate of this sheet is enclosed.

MANDEL & ADRIANO
55 South Lake Avenue, Suite 710
Pasadena, California 91101
(626) 395-7801

By: 
Name: Sarah B. Adriano
Reg. No.: 34,470
Initials: SBA
Customer No. 26,941

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Robert J. Peach, et al.

Serial No.: 09/865,321

Patent Examiner: Not yet known

Filed: May 23, 2001

Group Art Unit: 1646

Title: SOLUBLE CTLA4 MUTANT MOLECULES AND USES THEREOF

55 South Lake Ave., Suite 710
Pasadena, California 91101
February 24, 2003

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

PRELIMINARY AMENDMENT

Please amend the subject application as follows.

In the Specification:

Please replace the paragraph beginning at page 1, line 2-5, with the following rewritten paragraph:

-- This application claims the priority of U.S. Serial No. 60/287,576, filed May 26, 2000, (formerly U.S. Serial No. 09/579,927) and U.S. Serial No. 60/214,065, filed June 26, 2000. The contents of all of the foregoing applications in their entireties are incorporated by reference into the present application. --

Applicant: Robert J. Peach, et al.
U.S. Serial No: 09/865,321
Filed: May 23, 2001
Page: 2

REMARKS

This Amendment is the second Amendment submitted in connection with this application. The first Preliminary Amendment was submitted on November 22, 2002, canceling claims 1-66 and adding new claims 67-96. Claims 67-96 are pending and have not been examined as of the date of this Preliminary Amendment.

Amendments to the Specification

The amendment made at page 1, lines 2-5 merely corrects the continuing data of the specification as requested by the U.S. Patent and Trademark Office.

This Amendment is being submitted concurrently with a Request for Corrected Filing Receipt. Applicants first requested a corrected filing receipt on December 4, 2002. The Patent Office issued a "Response to Request for Corrected Filing Receipt", date mailed December 26, 2002. In the December 26 Response, the U.S. Patent Office advises Applicants that a corrected filing receipt cannot be issued until Applicants provide the relationship of the subject application to the applications to which priority is claimed. Accordingly, Applicants provide the relationship as part of this Amendment.

In the originally-filed subject application, Applicants claimed the priority of U.S. Serial Nos. 09/579,927, filed May 26, 2000, and 60/214,065, filed June 26, 2000. A photocopy of page 1 from the originally-filed subject application is provided as Exhibit A.

On March 12, 2001, Applicants submitted a Petition to convert U.S. Serial No. 09/579,927 to a provisional application under 37 C.F.R. §1.53(c)(2). A photocopy of the Petition is provided as Exhibit B.

Applicant: Robert J. Peach, et al.
U.S. Serial No: 09/865,321
Filed: May 23, 2001
Page: 3

On May 31, 2001, the U.S. Patent Office granted the Petition and issued 09/579,927 a new serial number (Exhibit C).

Accordingly, U.S. Serial No. 09/579,927 is now a provisional application assigned U.S. Serial No. 60/287,576, having a filing date of May 26, 2000.

These changes do not involve new matter. Entry of these changes is requested.

No fee is deemed necessary in connection with the filing of this Request for Corrected Filing Receipt. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-0306.

Pages entitled "Version with Markings to Show Changes in the Specification" are attached hereto to show the changes made to the application according to this Amendment.

Respectfully submitted,



Sarah B. Adriano
Registration No. 34,470
Roberta D. German
Registration No. 43,902
Patent Practitioners for Applicants
Mandel & Adriano
55 So. Lake Ave., Suite 710
Pasadena, California 91101
626/395-7801
Customer No: 26,941

Applicant: Robert J. Peach, et al.
U.S. Serial No: 09/865,321
Filed: May 23, 2001
Page: 4

VERSION WITH MARKINGS TO SHOW CHANGES IN THE SPECIFICATION

Please amend the paragraph beginning at page 1, line 2-5, to read as follows.

-- This application claims the priority of U.S. Serial No. 60/287,576, filed May 26, 2000,
(formerly U.S. Serial No. 09/579,927) and U.S. Serial No. 60/214,065, filed June 26,
2000. [benefit of the filing dates of U.S. Serial Nos. 09/579,927 (U.S. Provisional
Application Serial No. to be assigned), filed May 26, 2000; and 60/214,065 filed June 26,
2000.] The contents of all of the foregoing applications in their entireties are
incorporated by reference into the present application. --

Appendix D – Office Action of October 1, 2003



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,321	05/23/2001	Robert J. Peach	D0028PNP;30436.57USU1	2959
23914	7590	10/01/2003	EXAMINER	
STEPHEN B. DAVIS BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			ROARK, JESSICA H	
			ART UNIT	PAPER NUMBER
			1644	
			DATE MAILED: 10/01/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,321

Applicant(s)

PEACH ET AL.

Examiner

Jessica H. Roark

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/16/01, 8/17/01, 12/4/02 and 3/3/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 67-96 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1644

DETAILED ACTION

1. Applicant's amendments, filed 7/16/01, 8/17/01, 12/4/02 and 3/3/03 are acknowledged. Claims 1-66 have been cancelled. Claims 67-96 have been added and are pending.

Sequence Compliance

2. The instant application appears to be in sequence compliance for patent applications containing nucleotide sequence and/or amino acid sequence disclosures.

Restriction Requirement

3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 67-80 and 94-96, drawn to a soluble CTLA4 mutant molecule and pharmaceutical compositions comprising; classified in Class 530, subclass 350.
- II. Claims 81-93, drawn to an isolated nucleic acid encoding a soluble CTLA4 mutant molecule; vectors, host cells, and methods of producing the polypeptide, classified in Class 536, subclass 23.5; Class 435, subclasses 69.1, 455, 252.3, and 320.1.

The Inventions are distinct, each from the other because:

4. Groups I and II are different products. Nucleic acids and polypeptides differ with respect to their structures and physicochemical properties; therefore each product is patentably distinct.
5. Groups II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product, the protein can be made using an amino acid synthesizer.
6. These inventions are distinct for the reasons given above. In addition, they have acquired a separate status in the art as shown by different classification and/or recognized divergent subject matter. Further, a prior art search also requires a literature search, which would not be completely co-extensive. It is an undue burden for the examiner to search more than one invention. Therefore restriction for examination purposes as indicated is proper.

Art Unit: 1644

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Roark whose telephone number is (703) 605-1209. The examiner can normally be reached Monday through Friday from 8:00 AM to 4:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 872-9306.

Jessica Roark, Ph.D.
Patent Examiner
Technology Center 1600
September 29, 2003

Phillip Gambel
PHILLIP GAMBEL, PH.D.
PRIMARY EXAMINER
TECH CENTER 1600
9/29/03

Appendix E – Filing of Corrected Drawing on May 11, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

ROBERT PEACH, ET AL

APPLICATION NO: 09/865,321

FILED: 05/23/2001

FOR: SOLUBLE CTLA4 MUTANT MOLECULES

ART UNIT: 1644

EXAMINER: OUSPENSKI, ILIA

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT OF DRAWING

Sir:

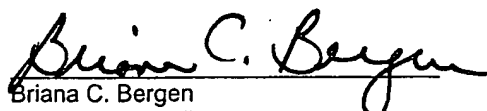
In response to the Notice of Drawing Inconsistency with Specification (PTO Form 1631) dated April 27, 2006, please replace Figure 11 with the corrected drawing submitted herewith containing Figures 11A and 11B. This amendment makes the Brief Description of the Drawings consistent with the drawings. This amendment does not involve new matter, and entry thereof is respectfully requested.

The PTO is invited to contact the undersigned with any questions relating to this response.

No fee is believed necessary in connection with the filing of this response. If any fee is necessary, the Patent Office is authorized to charge any fee to Deposit Account No. 19-3880.

Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000


Briana C. Bergen
Attorney for Applicant
Reg. No. 39,123
Phone: 609-252-4316
Date: May 11, 2006



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

NOTICE OF DRAWING INCONSISTENCY WITH SPECIFICATION

The drawings filed 5/23/01 have been received. However, an inconsistency exists between the drawings and the Brief Description of the Drawings in the specification.

Figures 11A & 11B are listed in the Brief Description of the Drawings in the specification but not contained in the Drawings.

Figures 11 are contained in the Drawings but not listed in the Brief Description of the Drawings in the specification.

Applicant is required to correct the above-noted inconsistency within a time period of **ONE MONTH or THIRTY (30) DAYS, whichever is longer**, from the mailing date of this Notice, or within the time remaining in the time period set forth in the Notice of Allowability (Form PTOL-37) to file corrected drawings, whichever is longer. **NO EXTENSION OF THIS TIME PERIOD MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b)**

Failure to correct the above noted inconsistency will result in **abandonment** of the application.

The file will be held in the Publishing Division to await the correction of the inconsistency.

Return Corrected Drawings/Specification to:

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

Office of Patent Publication/Publishing Division
Customer Service: 571-272-4200
1-888-786-0101

FORM PTO-1631 (REV. 10-03)

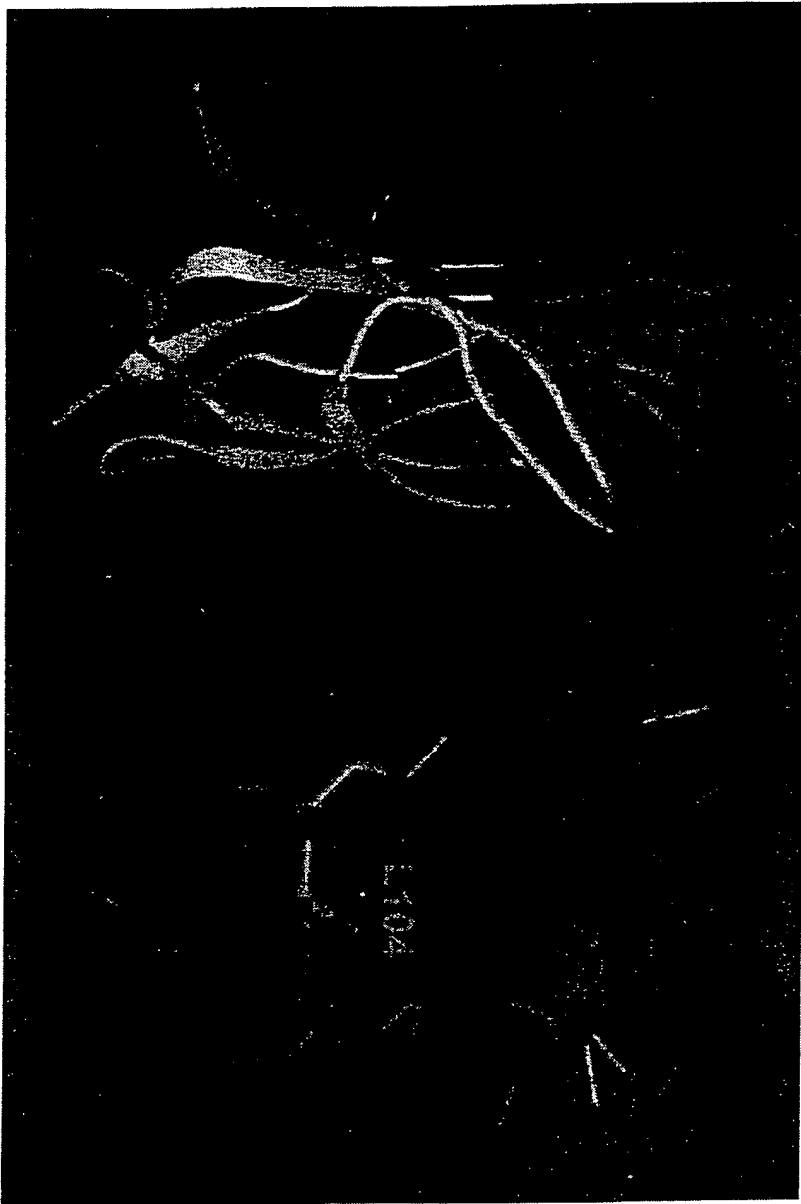


FIG. 11A

FIG. 11B

Appendix F – Utility Patent Application Transmittal

Please type a plus sign (+) inside this box → ☐

PTO/SB/05 (03-01)

Approved for use through 10/31/2002. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

UTILITY PATENT APPLICATION TRANSMITTAL (Only for new nonprovisional applications under 37 CFR 1.53(b))	Attorney Docket No.	D0028NP
	First Inventor	Robert J. Peach
	Title	SOLUBLE CTLA4 MUTANT MOLECULES
	Express Mail Label No	ET094879651US

APPLICATION ELEMENTS See MPEP chapter 600 concerning utility patent application contents.	ADDRESS TO: Assistant Commissioner for Patents Box Patent Application Washington, DC 20231
1. <input checked="" type="checkbox"/> Fee Transmittal Form (e.g., PTO/SB/17) <i>(Submit an original and a duplicate for fee processing)</i>	7. <input type="checkbox"/> CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix)
2. <input type="checkbox"/> Applicant claims small entity status See 37 CFR 1.27.	8. Nucleotide and/or Amino Acid Sequence Submission <i>(if applicable, all necessary)</i>
3. <input checked="" type="checkbox"/> Specification [Total Pages 51] <i>(preferred arrangement set forth below)</i> <ul style="list-style-type: none">- Descriptive title of the invention- Cross Reference to Related Applications- Statement Regarding Fed sponsored R & D- Reference to sequence listing, a table, or a computer program listing appendix- Background of the Invention- Brief Summary of the Invention- Brief Description of the Drawings <i>(if filed)</i>- Detailed Description- Claim(s)- Abstract of the Disclosure	a. <input type="checkbox"/> Computer Readable Form (CRF) b. Specification Sequence Listing on: <ul style="list-style-type: none">i. <input type="checkbox"/> CD-ROM or CD-R (2 copies); orii. <input type="checkbox"/> paper c. <input type="checkbox"/> Statements verifying identity of above copies
4. <input checked="" type="checkbox"/> Drawing(s) (35 U.S.C. 113) [Total Sheets 12]	ACCOMPANYING APPLICATION PARTS
5. Oath or Declaration [Total Pages] <ul style="list-style-type: none">a. <input type="checkbox"/> Newly executed (original or copy)b. <input type="checkbox"/> Copy from a prior application (37 CFR 1.63 (d)) <i>(for continuation/divisional with Box 18 completed)</i><ul style="list-style-type: none">i. <input type="checkbox"/> DELETION OF INVENTOR(S) Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).	9. <input type="checkbox"/> Assignment Papers (cover sheet & document(s))
6. <input checked="" type="checkbox"/> Application Data Sheet. See 37 CFR 1.76	10. <input type="checkbox"/> 37 CFR 3.73(b) Statement <input type="checkbox"/> Power of Attorney <i>(when there is an assignee)</i>
	11. <input type="checkbox"/> English Translation Document <i>(if applicable)</i>
	12. <input type="checkbox"/> Information Disclosure Statement (IDS)/PTO-1449 <input type="checkbox"/> Copies of IDS Citations
	13. <input type="checkbox"/> Preliminary Amendment
	14. <input checked="" type="checkbox"/> Return Receipt Postcard (MPEP 503) <i>(Should be specifically itemized)</i>
	15. <input type="checkbox"/> Certified Copy of Priority Document(s) <i>(if foreign priority is claimed)</i>
	16. <input type="checkbox"/> Nonpublication Request under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent.
	17. <input checked="" type="checkbox"/> Other: <u>transmittal sheet, check</u>

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:

☐ Continuation ☐ Divisional ☐ Continuation-in-part (CIP)

of prior application No. _____ / _____

Prior application information.

Examiner _____

Group Art Unit _____

For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

19. CORRESPONDENCE ADDRESS				
<input checked="" type="checkbox"/> Customer Number or Bar Code Label	23,914		or	<input type="checkbox"/> Correspondence address below
Name				
Address				
City		State	Zip Code	
Country		Telephone	Fax	

Name (Print/Type)	Sarah B. Adriano	Registration No. (Attorney/Agent)	34,470
Signature	<i>Sarah B. Adriano</i>	Date	5/23/01

Burden Hour Statement. This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS SEND TO Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

11002 U.S. PTO
09/865321
05/23/01

Appendix G – Notice of Drawing Inconsistency with Specification



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

D0028-US-NP
SHER

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,321	05/23/2001	Robert J. Peach	D0028PNP;30436.57USU1	2959
23914	7590	04/27/2006	EXAMINER	
LOUIS J. WILLE BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			Ouspenski, ILIA I	
			ART UNIT	PAPER NUMBER
			1644	
DATE MAILED: 04/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
BMS PATENT LAW

MAY 01 2006

Docketed Item

Due Date

Attorney

Misc-File Corrected Drawings

5/27/2006

AS

mf



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

NOTICE OF DRAWING INCONSISTENCY WITH SPECIFICATION

The drawings filed 5/23/01 have been received. However, an inconsistency exists between the drawings and the Brief Description of the Drawings in the specification.

Figures 11A & 11B are listed in the Brief Description of the Drawings in the specification but not contained in the Drawings.

Figures 11 are contained in the Drawings but not listed in the Brief Description of the Drawings in the specification.

Applicant is required to correct the above-noted inconsistency within a time period of **ONE MONTH or THIRTY (30) DAYS, whichever is longer**, from the mailing date of this Notice, or within the time remaining in the time period set forth in the Notice of Allowability (Form PTOL-37) to file corrected drawings, whichever is longer. **NO EXTENSION OF THIS TIME PERIOD MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b)**

Failure to correct the above noted inconsistency will result in **abandonment** of the application.

The file will be held in the Publishing Division to await the correction of the inconsistency.

Return Corrected Drawings/Specification to:

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Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

Office of Patent Publication/Publishing Division
Customer Service: 571-272-4200
1-888-786-0101

FORM PTO-1631 (REV. 10-03)

Appendix H – Notice Regarding Drawings



D0028-US-NP
SHER

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NUMBER 09/865321	FILING/RECEIPT DATE 05/23/2001	FIRST NAMES APPLICANT PEACH, ROBERT J.	ATTORNEY DOCKET NUMBER D0028PNP;30436.57USU 1
--	--	--	---

LOUIS J. WILLE
BRISTOL-MYERS SQUIBB COMPANY
PATENT DEPARTMENT
P O BOX 4000
PRINCETON NJ 08543-4000

RECEIVED
BMS PATENT LAW

Examiner
OUSPENSKI ILIA I
Art Unit
1644

JUN 05 2006

Docketed Item Drawings
Due Date 8/01/2006
Attorney AS *mt*

Date Mailed: 6/1/06

Notice Regarding Drawings

Corrected drawings for the above-identified application, received in the USPTO on 05/23/2001 are still not acceptable for the reason(s) identified on the attached PTO-948. Applicant is given one opportunity to correct the informalities within a two-month time period from the mailing date of this Notice. **THIS TIME PERIOD IS NOT EXTENDABLE UNDER EITHER 37 CFR 1.136(a) OR 1.136(b).** Failure to take corrective action within the set period will result in abandonment of the application.

ATTACHMENT: PTO-948 Notice of Draftsperson's Patent Review
RETURN CORRECTED DRAWINGS TO:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

John Fitzhugh
John Fitzhugh
Office Of Patents Publication
Publishing Division
703-305-0333 ext-137

NOTICE OF DRAFTSPERSON'S PATENT DRAWING REVIEW

The drawing(s) filed (insert date) 5/11/06 are:

- A. ☐ approved by the Draftsperson under 37 CFR 1.84 or 1.152.
B. ☒ objected to by the Draftsperson under 37 CFR 1.84 or 1.152 for the reasons indicated below. Corrected drawings are required.

1. DRAWINGS. 37 CFR 1.84(a): Acceptable categories of drawings: Black ink or Color (3 sets required).

☐ Color drawings are not acceptable until petition is granted. Fig(s) _____

☐ Pencil and non black ink not permitted. Fig(s) _____

2. PHOTOGRAPHS. 37 CFR 1.84(b)

☐ One (1) full-tone set is required. Fig(s) _____

☐ Photographs may not be mounted. 37 CFR 1.84(e)

☐ Photographs must meet paper size requirements of 37 CFR 1.84(f). Fig(s) _____

☐ Poor quality (half-tone). Fig(s) _____

3. TYPE OF PAPER. 37 CFR 1.84(e)

☐ Paper not flexible, strong, white, and durable.

Fig(s) _____

☐ Erasures, alterations, overwritings, interlineations, folds, copy machine marks not accepted.

Fig(s) _____

4. SIZE OF PAPER. 37 CFR 1.84(f): Acceptable sizes:

21.0 cm by 29.7 cm (DIN size A4) or

21.6 cm by 27.9 cm (8 1/2 x 11 inches)

☐ All drawing sheets not the same size.

Sheet(s) _____

☐ Drawings sheets not an acceptable size. Fig(s) _____

5. MARGINS. 37 CFR 1.84(g): Acceptable margins:

Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm

☐ Margins not acceptable. Fig(s) _____

Top (T) _____ Left (L) _____

Right (R) _____ Bottom (B) _____

6. VIEWS. 37 CFR 1.84(h)

REMINDER: Specification may require revision to correspond to drawing changes, e.g., if Fig. 1 is changed to Fig. 1A, Fig. 1B and Fig. 1C, etc., the specification, at the Brief Description of the Drawings, must likewise be changed.

☐ Views not labeled separately or properly.

Fig(s) _____

7. SECTIONAL VIEWS. 37 CFR 1.84(h)(3)

☐ Sectional designation should be noted with Arabic or Roman numbers. Fig(s) _____

8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i)

☐ Words do not appear on a horizontal, left-to-right fashion when page is either upright or turned so that the top becomes the right side, except for graphs. Fig(s) _____

9. SCALE. 37 CFR 1.84(k)

☐ Scale not large enough to show mechanism without crowding when drawing is reduced in size to two-thirds in reproduction.

Fig(s) _____

10. CHARACTER OF LINES, NUMBERS, & LETTERS. 37 CFR 1.84(l)

☒ Lines, numbers & letters not uniformly thick and well defined, clean/durable, and black (poor line quality). Fig(s) 11/12

11. SHADING. 37 CFR 1.84(m)

☐ Solid black areas pale. Fig(s) _____

☐ Solid black shading not permitted. Fig(s) _____

12. NUMBERS, LETTERS, & REFERENCE CHARACTERS. 37 CFR 1.84(p)

☐ Numbers and reference characters not plain and legible. Fig(s) _____

☐ Figure legends are poor. Fig(s) _____

☐ Numbers and reference characters not oriented in the same direction as the view. 37 CFR 1.84(p)(1) Fig(s) _____

☐ English alphabet not used. 37 CFR 1.84(p)(2) Fig(s) _____

☐ Numbers, letters and reference characters must be at least 32 cm (1/8 inch) in height. 37 CFR 1.84(p)(3). Fig(s) _____

13. LEAD LINES. 37 CFR 1.84(q)

☐ Lead lines missing. Fig(s) _____

14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.84(t)

☐ Sheets not numbered consecutively, and in Arabic numbers beginning with number 1. Sheet(s) _____

15. NUMBERING OF VIEWS. 37 CFR 1.84(u)

☐ Views not numbered consecutively, and in Arabic numerals, beginning with number 1. Fig(s) _____

16. DESIGN DRAWINGS. 37 CFR 1.152

☐ Surface shading shown not appropriate.

Fig(s) _____

☐ Solid black surface shading is not permitted except when used to represent the color black as well as color contrast. Fig(s) _____

COMMENTS:

Reviewer [Signature]

If you have questions, call (703) 305-8404.

Date 5/30/06

Attachment to Paper No. _____

Appendix I – Filing of Corrected Drawings on June 9, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

ROBERT PEACH, ET AL

APPLICATION NO: 09/865,321

FILED: 05/23/2001

FOR: SOLUBLE CTLA4 MUTANT MOLECULES

ART UNIT: 1644

EXAMINER: OUSPENSKI, ILIA

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NOTICE REGARDING DRAWINGS

Sir:

This communication is in response to the Notice Regarding Drawings dated June 1, 2006, wherein the Draftsperson objects to Figures 11 and 12. Accordingly, replacement sheets for FIGS. 11A, 11B and 12 (2 sheets total) are enclosed herewith which overcome the Draftsperson's objections. No new matter is added, and acceptance of these figures is respectfully requested.

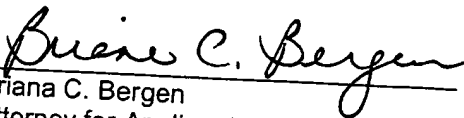
The PTO is invited to contact the undersigned with any questions relating to this response.

No fee is believed necessary in connection with the filing of this response. If any fee is necessary, the Patent Office is authorized to charge any fee to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Co.

Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000

Date: June 9, 2006


Briana C. Bergen
Attorney for Applicant
Reg. No. 39,123
Phone: 609-252-4316

D0028 NP
REPLACEMENT SHEET

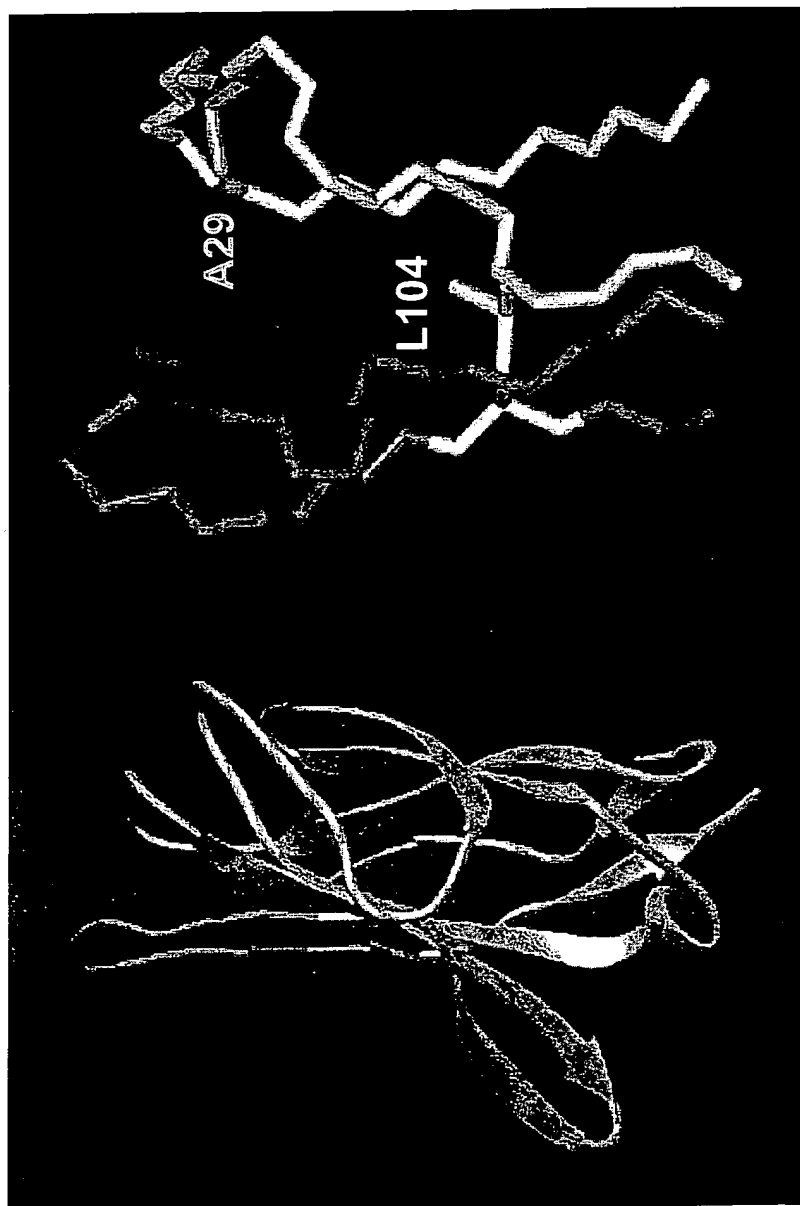


FIG. 11A

FIG. 11B

D0028 NP
REPLACEMENT SHEET

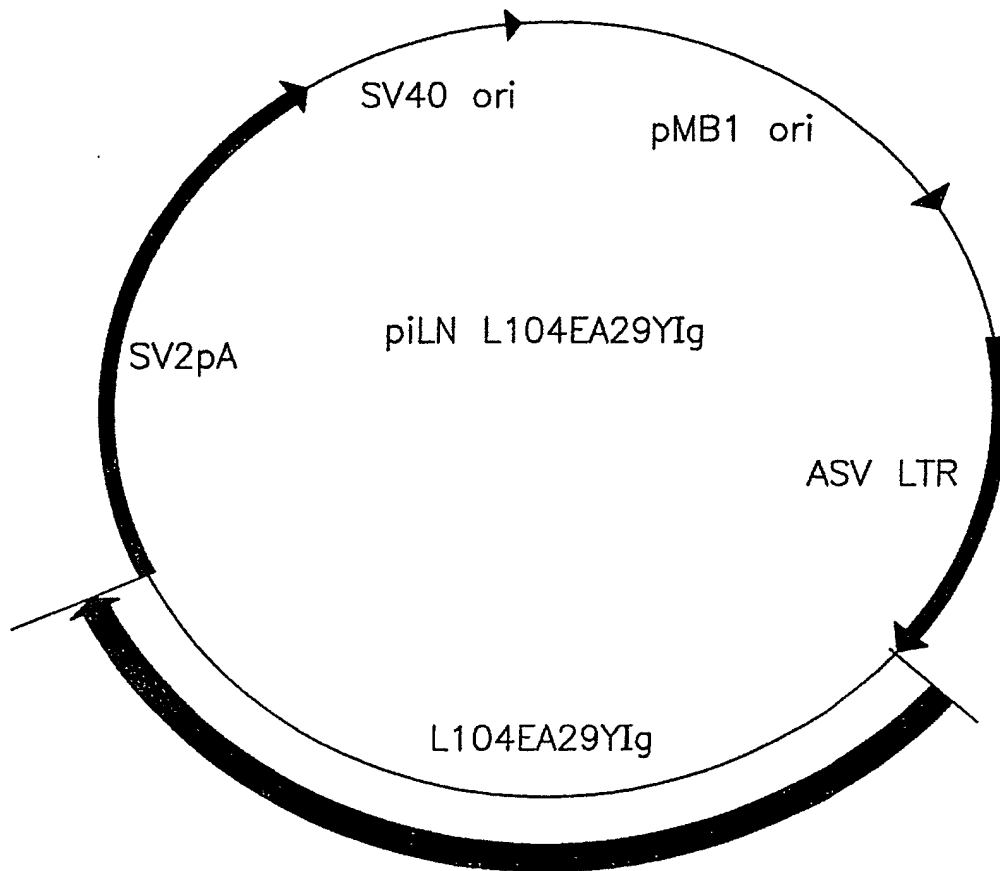


FIG. 12

Appendix J – U.S. Pub. No. 2002/0182211 (Front Page)



US 20020182211A1

(19) United States

(12) Patent Application Publication (10) Pub. No.: US 2002/0182211 A1

Peach et al.

(43) Pub. Date:

Dec. 5, 2002

(54) SOLUBLE CTLA4 MUTANT MOLECULES
AND USES THEREOF

Related U.S. Application Data

(60) Provisional application No. 60/214,065, filed on Jun.
26, 2000.(76) Inventors: Robert J. Peach, San Diego, CA (US);
Joseph R. Naemura, Bellevue, WA
(US); Peter S. Linsley, Seattle, WA
(US); Jurgen Bajorath, Lynwood, WA
(US)

Publication Classification

(51) Int. Cl.⁷ A61K 39/395; C07H 21/04;
C07K 16/28; C12N 5/06;
C12P 21/02
(52) U.S. Cl. 424/143.1; 530/388.22; 435/69.1;
435/326; 435/320.1; 536/23.53

Correspondence Address:

STEPHEN B. DAVIS
BRISTOL-MYERS SQUIBB COMPANY
PATENT DEPARTMENT
P O BOX 4000
PRINCETON, NJ 08543-4000 (US)

(57) ABSTRACT

The present invention provides soluble CTLA4 mutant molecules which bind with greater avidity to the CD80 and/or CD86 antigen than wild type CTLA4 or non-mutated CTLA4lg. The soluble CTLA4 molecules have a first amino acid sequence comprising the extracellular domain of CTLA4, where certain amino acid residues within the S25-R33 region and M97-G107 region are mutated. The mutant molecules of the invention may also include a second amino acid sequence which increases the solubility of the mutant molecule.

(21) Appl. No.: 09/865,321

(22) Filed: May 23, 2001

ATGGGTGTACTGCTCACAGAGGACGCTGCTCACTCTGGTCTTGCACCTCTGTTTCCA -19
M--G--V--L--L--T--Q--R--T--L--L--S--L--V--L--A--L--L--F--P-- -7
AGCATGGGAGCAATGCAATGCACTGGGCCAGCTCTGTGTGTACTGGCGAGCGGA +42
S--M--A--S--M--A--M--E--V--A--Q--P--A--V--V--L--A--S--S--R-- +14
+1
GGCATGCTAGCTTTGTGTGTGATATGCACTCCAGGCAATATATCTAGGTCGGGTTG +102
G--I--A--S--F--V--C--E--Y--A--S--P--G--K--Y--T--E--V--R--V-- +34
ACAGTCTTGGGAGCTGACAGCCAGGTGACTGAACTCTGTGGCGAACCTACATGATG +162
T--V--L--R--Q--A--D--S--Q--V--T--S--V--C--A--A--T--Y--M--N-- +54
GGGAATGAGTTGACCTTCTAGATGATTCATCTCGACGGGCACTCCAGTGGAAATCAA +222
G--N--E--L--T--F--L--D--S--I--C--T--G--T--S--S--G--N--Q-- +74
GTGAACCTCACTATCCAGGACTGAGGCGCATGAGACGGGACTCTACATCTGCAAGGTG +282
V--N--L--T--I--Q--G--L--R--A--H--D--T--G--L--Y--I--C--K--V-- +94
GAGCTCATGTACCCAGCCGCTACTACAGAGGCAATGCAAGCAAGCAACCAATTTATGTA +342
E--L--M--Y--P--P--P--Y--Y--E--G--I--G--N--G--T--Q--I--Y--V-- +114
ATTGATCCAGAACCTGCGGAGTTCTGATCAAGGAGCCCAATCTTCTGACAAACTCAC +402
I--D--P--E--P--C--P--D--S--D--Q--E--P--K--S--S--D--K--T--H-- +134
ACATCCCAACCTTCCCAAGCACTGAACTCTGGGGGATGCTGATCTTCTCTTCCCC +462
T--S--P--P--S--P--A--P--S--L--L--G--G--S--S--V--F--L--F--P--P-- +154
CCAAACCCAGGACACCTCATGATCTCCGGACCCCTGAGGTCAATGCTGTGGTGG +522
P--X--P--X--D--T--L--M--I--S--R--T--P--E--V--T--C--V--V--V-- +174
GAGCTGAGCCAGGAGACCTTGAGGTCAAGTTCAACTGCTACGTGGACGGCTGGAGGTG +582
D--V--S--H--E--D--P--E--Y--K--F--H--W--Y--V--D--G--V--E--V-- +194
CATATGCCAAGACAAAGCCGCGGAGAGCACTACAAAGCAACCTACCTGTGTGCAAC +642
H--N--A--K--T--K--P--R--E--E--Q--Y--N--S--T--Y--R--V--V--S-- +214
GTCTCTACCTCTCTGACAGGAGCTGGCTGAATGGCAAGGAGTACAGTGCAGGTCTCC +762
V--L--T--V--L--H--Q--D--H--L--H--G--K--E--Y--K--C--K--V--S-- +234
AACAAAGCCCTCCAGCCCTCATGAGAAACCATCTCCAAAGCAAGGGCGGCGCCGA +762
H--K--A--L--P--A--P--I--E--K--T--I--S--K--A--K--G--Q--P--P--R-- +254
GAACCAAGGTGTACACCTGCCCCCATCCCGGAGTGAAGTGAACCAAGCAAGGTGAGC +822
E--P--Q--V--Y--T--L--P--P--S--R--D--E--L--T--K--N--Q--V--S-- +274
CTGACCTGCTGTGCAAGGCTTCTATCCAGGCACTGCGCTGTGAGTGGAGAGCAAT +882
L--T--C--L--V--K--G--F--Y--P--S--D--I--A--V--B--N--S--S--S-- +294
GGGACCGGAGAACAACTACAAGACCAAGCTCCCGTGTGACTCGAAGGCTCTCTC +942
G--Q--P--E--H--N--K--T--T--P--P--V--L--D--S--D--G--S--F-- +314
TTCTCTACAGCAAGCTCACCTGTGACAGAGAGAGGTGGAGCAGGGAAATCTCTCA +1002
P--L--Y--S--K--L--T--V--D--K--S--R--N--Q--Q--G--N--Y--F--S-- +334
TGCTCTGTGATGATGAGGCTCTGACAGCACTACAGCGAGAGAGCTCTCCCTGTCT +1062
C--S--V--M--H--E--A--L--H--H--H--Y--T--Q--E--S--L--S--L--S-- +354
COGGTAAATGA
P--G--K--*

Appendix K – Issue Notification



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APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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LOUIS J. WILIE
BRISTOL-MYERS SQUIBB COMPANY
PATENT DEPARTMENT
P O BOX 4000
PRINCETON, NJ 08543-4000

ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment is 253 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

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